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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Eric C. Hannah, et al.

Serial No.: 09/690,512

Filed: October 17, 2000

For: Ensuring that Advertisements
Are Played

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Art Unit: 3622

Examiner: Jean D. Janvier

Atty Docket: ITL.0482US
(P10030)

Assignee: Intel Corporation

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This responds to the new arguments set forth in the Examiner's Answer.

With respect to the rejection of claims 5, 15, and 25 as being indefinite under Section 112, the Examiner maintains the novel and non-statutory rejection based on prematureness.

The rejection confuses the functions of the specification and claims and insists that claims be narrowed merely because the claims themselves do not tell you how to do what is claimed. This is particularly absurd with respect to claim 5 which is a method claim. Clearly, the claim tells you what to do. While the Examiner may wish that more details were set forth in the claim, one skilled in the art can clearly understand what is being covered.

The Examiner notes that it is not clear how a watermark embedded into a content can help determine a speed at which content is being played. But explanations are not necessary in claims. The claims cover what you do, not how the thing works. The rejection says that what

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you do is determine whether the advertisement was played at a predetermined speed. One skilled in the art could not reasonably have any objection to this claim. The rejection is spurious, baseless, and premised on a fundamental misapprehension of the function of claims.

The assumption that the watermark has to help determine the speed at which the content is being played is baseless. The watermark is monitored and, according to dependent claim 5, that monitoring must include determining the speed that the advertisement was played. The claim does not say that the speed is determined by the watermark itself, but only that monitoring the watermark also includes determining a speed. As explained in the specification at page 7, lines 3-10, when a flag is set, the watermark determines whether the commercial has been played appropriately. This includes determining whether the commercial was played at the appropriate speed. To do this, the watermark detection may, in some embodiments, access predetermined characterizing information to determine what an appropriate speed would be and then simply compares the speed at which the commercial is played with that information. See page 7, lines 11-22.

There is nothing in the claim that one skilled in the art would not understand. The claim is absolutely clear and simple. Therefore, the rejection should be reversed.

Claimed elements are asserted to be missing from the references in the Appeal Brief. The rejection concedes that the missing elements are not in the cited references explicitly and then attempts to argue that they are taught implicitly or, as now set forth on page 5 of the Answer, "by default." This is, again, a continuing effort to evade the requirements clearly set forth in the Manual of Patent Examining Procedures for rejections based on inherency. Section 2112 makes it clear that in order to make out such a rejection, the Examiner must show that the element is necessarily present. The Examiner has made no effort to make this showing and continues to avoid making it, despite the fact that it has been pointed out repeatedly. As a result, a *prima facie* rejection is not made out and the rejection posited should be reversed.

The assertions in bold on the bottom of page 5 are not based on anything in the reference, but are simply evidence of the use of hindsight reasoning by the Examiner. The Examiner's entire argument on the bottom of page 5, the entire page 6, and the top of page 7, with respect to claim 1, cites not a single thing in the reference. It is all a concoction of the Examiner's imagination without any support whatsoever. This is not materially different from the exposition

of the rejection on pages 3 and 4 which simply goes off on all kinds of suppositions made by the Examiner without resort to anything in the cited references.

For example, there is a discussion of the Proctor & Gamble receipts that are apparently issued to TV viewers. But nothing within any of this material indicates that an indication of an advertisement being played is associated with an identifier for a particular user. Nowhere is there any mention of an identifier for a particular user. The rejection at page 4, line 8, says that an identified or specific TV viewer who accumulates 50 receipts can redeem them. But nothing in the material says that the viewer is identified. The language in the reference is "Thus, a TV viewer who accumulates 50 receipts" See column 58, line 20. This somehow gets transformed in the rejection to "an identified or a specific TV viewer." Nothing in the reference supports such a conclusion.

An inherency rejection requires that the user must necessarily have an ID. But there is no reason from the reference why the user would have an ID. All the system cares about is that somebody watched the advertisement. It may not matter to that inventor whether the one who watched the advertisement gets the coupon or not. In other words, the inventor of the cited Rodriguez patent may not have thought of the problem that people may simply obtain the receipts even though they did not watch the program.

Thus, returning to the new comments starting at the bottom of page 5, the Examiner submits that the advertisement has, by default, a unique identifier. No basis for this is provided and it is not relevant to the issue raised in the Appeal Brief. Even if the advertisement had a file name or identifier (which it does not), there is still no identifier for each user. Again, on page 6, line 4, the Examiner argues that "Rodriquez supports compensating a subscriber or a specific user" That is the point. Rodriquez does not care whether it is a specific user, a subscriber, or anyone. There is no identifier for any user. Arguments that the advertisements have an identifier, while unsupported, still fail to meet the claimed limitation of associating an indication that an advertisement was played "with an identifier for a particular user."

The Examiner somehow concludes that because he fashioned an argument that there was an identifier for a particular advertisement, that there must be an identifier for a particular user. Certainly, the illogic applied is illusory. Therefore, the rejection should be reversed.

Respectfully submitted,

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